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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,065	10/16/2003	Christopher R. McGee	020375-033110US	8138

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
07/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/688,065	MCGEE ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the papers filed 6/10/08.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry et al (US6336098) in view of Fajkowski (US5905246).

Regarding claims 1, 4, 12, 15, 22, 23, Fortenberry et al teaches a system that enables coupon creators to define coupon parameters, creates, stores and distributes electronic coupons to consumer users [abstract, col 2: lines 10-35]. The coupons can be defined as being redeemable with selected merchants [6:58-65, 7:10-19]. Redemption includes presenting the coupon and verifying that the coupon parameters/restrictions (proper product identifier, proper merchant identifier) are met [2:53-60, 6:1-20]. Fortenberry et al does not teach redemption of e-coupons at a physical retailer using a discount instrument. Fajkowski teaches e-coupon redemption at a physical POS where the user presents s coupon card having a user identifier associated therewith [4:4-6]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a card with that of Fortenberry et al so that

brick-and-mortar shoppers can use the system of Fortenberry et al for discounts. Fortenberry et al and Fajkowski both speak of preventing coupon fraud and it would have been obvious to one of ordinary skill at the time of the invention to have validated all of the coupon parameters with the central host during POS validation so that the proper discount amount, productID, merchantID can be confirmed before awarding the associated discount (i.e. obvious for the host to inform the requesting POS that the redemption parameters have been met and to authorize redemption for amount xxx as defined by the stored coupon parameters). Inasmuch as pertinent, it would have been obvious to one of ordinary skill at the time of the invention to have defined a coupon redeemable at only one merchant.

Regarding claims 2, 3, 13, 14, it would have been obvious to one of ordinary skill at the time of the invention to have indicated that a coupon not being redeemed at the proper merchant or not associated with the proper productID will not be accepted so as to inform the consumer why the attempted coupon failed.

Regarding claims 5-7, 16-18, Fortenberry et al keeps records of all redemption data and it would have been obvious to one of ordinary skill at the time of the invention to have preserved failed redemption attempts as well, especially where the prior art indicates a desire to track potential redemption fraud. Any of the data in the stored redemption records can be taken to be "criteria" (for initiating of marketing efforts).

Regarding claims 8-11, 19-21, Fortenberry et al teaches that the retailer can reconcile (receive payments covering the discounted amounts) the coupons. It would have been obvious to one of ordinary skill at the time of the invention to have provided

retailers reports that summarize coupon totals in support of the reconciliation process. This would enable the retailers to confirm that they have been properly credited for discounts extended on behalf of the coupon issuers.

Response to Arguments

The fact that the coupons are redeemable only at participating merchants (the discount arrangements specify participating retailers) indicates they are clearly associated with merchants. Inasmuch as pertinent, it would have been obvious to one of ordinary skill at the time of the invention to have defined a coupon redeemable at (specific to) only one merchant. Applicant argues that there is no suggestion that any test is performed at the host to determine whether the merchant party is a merchant with which a discount arrangement is associated. As stated in the action, verifying that the server-defined coupon is being redeemed at a participating merchant reads on applicant's claimed "test". Just because a coupon exists for merchant A does not mean that a user having that coupon can redeem it at merchant B. The host would ensure that the criteria for the coupon are met, including is the coupon associated with the user, is it the proper product ID, is it the proper merchantID, etc. The notion that it would have been obvious to use a user identifier in order to identifier the user's coupons makes it clear that a single user identifier/instrument allows for a user to have several coupons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc